

Notice of Allowability

Application No.

09/806,629

Applicant(s)

FRANCES, JEAN-MARC

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to interview on November 5, 2003.
2. ☒ The allowed claim(s) is/are 22 and 24-28.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. _____. |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____ | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Jean-Louis Seugnet on November 5, 2003.

The application has been amended as follows:

In claim 27, please remove compound (d) on page 18 of the amendment.

In claim 28, line 2, please replace the word "step" with

-- steps--.

Also in claim 28, line 2, please replace the word "using" with

-- shaping and curing --.

In a telephone interview with Applicant on the aforementioned date, the Examiner explained that the term "using" was inappropriate to disclose as a step within the confines of a method claim because it was not clear in what manner the compound was to be used. That is, the word "using" is imprecise as an indication of a particular manipulation of the claimed composition insofar as it does not clearly define the action taken on said composition. It was, therefore, suggested that Applicant consider substituting the phrase "shaping and curing" for "using" to add clarity to the claimed method.

As for claim 27, it had been indicated previously that this claim was allowable on the basis that the particular epoxy-functionalized polysiloxanes disclosed therein were not taught by the reference. The Examiner now believes that this statement was not entirely true and merits further comment. Priou et al. separately provides general formulaic representations of both the internal and terminal units of the linear siloxane polymer component of their composition as well as several embodiments of substituent Y. Priou also provides an indication of the size of the polymer by disclosing a preferred range of polymer viscosities. (Polymer viscosity is, of course, proportionate to its size/structure.) Taken in sum, the different combinations of possible internal- and terminal units, and polymer size represent, in the Examiner's view, a substantially large range of possible compounds that do, in fact, encompass most of the compounds set forth in claim 27. That being said, section 2131.03 of the MPEP instructs that, when the claims are directed to a narrow range and the reference teaches a broad range, it may be reasonable to conclude that the narrow range has not been disclosed with sufficient specificity to warrant a finding of anticipation. It was decided that the reference had not met this standard with respect to any of compounds (a), (b), (c), (e), (f), and (h). On the other hand, the formula for (d) is, itself, representative of literally hundreds of siloxane polymers (or thousands if one considers that the variable R_0 denotes any one of an assortment of alkyl-, cycloalkyl-, aryl-, or alkoxy substituents) hence the Examiner feels that the reference has been disclosed (d) with sufficient specificity. Accordingly, it was recommended that Applicant remove mention of compound (d) to obviate the art. (Compound (g) is a cyclosiloxane that is not anticipated or rendered obvious by Priou.)

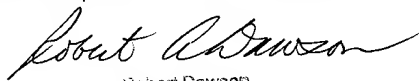
The 3M company possesses several patents teaching dental compositions that are somewhat similar to that presently claimed but, nonetheless, were not considered to be applicable because it would have been necessary to judiciously select the proper ingredients out of a laundry list of epoxy-functional compounds, photosensitizers, and photoinitiators to arrive at the instant invention. That is, there was some small degree of overlap in the description of each of these materials but the Examiner could not ascertain what would have motivated one of ordinary skill to select a combination of epoxy-functional silicone, photosensitizer, and photoinitiator such that a composition equivalent to Applicant's was realized.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

November 7, 2003


Robert Dawson
Supervisory Patent Examiner
Technology Center 1700